

REMARKS**INTRODUCTION**

In accordance with the foregoing, claims 1, 10, 11 and 12 have been amended and new claim 13 has been added. No new matter has been submitted.

Claims 1-13 are pending and under consideration.

REJECTION UNDER 35 USC 103

Claims 1-2, 6 and 9-12 stand rejected under 35 USC § 103 as being obvious over Paull et al., U.S. Patent No. 5,945,981. This rejection is respectfully traversed.

The outstanding rejection of the independent claims would appear to be based on a modification of Paull et al. to be a wireless mouse. Specifically, the Office Action details all the elements that Paull et al. discloses and indicates that Paull et al. fails to disclose the use of a wireless mouse. Thereafter, the Office Action indicates that wireless mice are well known. The rejection thereafter would logically follow that the rejection would conclude with a rationale for modifying Paull et al. to use a wireless mouse. Such a modification of Paull et al. would thus fundamentally change the purpose of Paull et al., and thus would not have been obvious.

Rather, after detailing the claimed features that Paull et al. discloses, the Office Action reverses the rejection rationale and indicates that it would have been obvious to modify an unknown wireless mouse to include the system of Paull et al. Specifically, the Office Action sets forth that the rationale for such a modification of a yet unknown wireless mouse to include the charging system of Paull et al. would be "because it provides a convenient way to supply power to the cradle from the computer's batteries when no external power source is available for either device."

It is respectfully submitted that it would not have been obvious to modify a yet unknown wireless mouse with the charging system of Paull et al. In addition, it is respectfully submitted that the operation of the charging system of Paull et al. is unrelated to the proffered motivation for modifying the yet unknown wireless mouse.

Paull et al. sets forth a wireless pointer 130 that emits a light beam and a receiver 105 with an optical receiver 220 to detect the movement of the light beam. "The receiver 105 receives the light pulses emitted from the pen. The receiver 105 computes the position coordinates of the pen 130 and outputs them, via cable 120, to the computer 115." Paull et al.

col. 4, lines 36-38.

Paull et al. would not appear to particularly describe the manner in which receiver 105 obtains power. Paull et al. would appear to merely illustrate that power is received through cable 120 connected to the computer, e.g., a typical USB connection allowing power to be supplied to a secondary device, which is also the same cable 120 the receiver 105 forwards signals from wireless pointer 130. In addition, Paull et al. would not appear to disclose anything related to having a particular connecting arrangement for supplying power to a cradle in case the power to the computer was interrupted. Conversely, Paull et al. would appear to work equally well with either a desktop or a portable computer working off batteries. Thus, Paull et al. does not provide the proffered motivation of supplying power to a cradle from a computer in case an external power supply is interrupted.

Thus, Paull et al. would not appear to be related to providing "a convenient way to supply power to the cradle from the computer's batteries when no external power source is available for either device." Paull et al. would not appear to even disclose an external power source other than the computer.

Paull et al. would appear to only disclose an available wire 230 from receiver 105 for powering wireless pointer 130 when the battery of wireless pointer 103 is low. The wireless pointer system of Paull et al. would at all times appear to require the interaction between receiver 105 and pointer 103. Thus, as illustrated in FIG. 5 of Paull et al., to power pointer 130 when the battery is low a cable 230 is connected thereto and that cable 230 is connected to receiver 105, from which cable 230 receives power.

Thus, in addition to Paull et al. not appearing to disclose an external power source other than the computer, Paull et al. would similarly appear to teach to have a connector to the wireless device supplied power from the receiver if the battery in the wireless device is low.

Again it is noted that the Office Action has indicated that the rationale for modifying a yet unknown wireless mouse to include the power supplying system of Paull et al. would be for the convenience of supplying an unknown cradle of the unknown wireless mouse with power "from the computer's batteries" when no external power is supplied from either device.

As noted above, Paull et al. does not support the proffered motivation for modifying a yet unknown wireless mouse.

As further noted above, the Office Action has set forth a rejection based primarily on

modifying an unknown device. The Office Action merely takes Official Notice that wireless devices are well known. It is respectfully submitted that such rationale is improper.

As is well understood, while "official notice" may be relied upon, as noted in MPEP §2144.03, these circumstances should be rare when an application is under final rejection or action under 37 CFR §1.113. Official Notice unsupported by documentary evidence should be only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known and only when such facts are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection.

Herein, the use of Official Notice to provide the primary unknown wireless mouse, and base a rejection on the modification of the same, is improper as the use of the Official Notice in this case does not serve to only fill in the gaps, but rather is the primary underlying support for the rejection.

It is improper to merely deem something obvious without any teaching/suggestion, or the taking of Judicial Notice. If the U.S. Patent and Trademark Office wishes to take Judicial Notice that the proposed structural and functional modification is notoriously well known, it is respectfully requested that supporting evidence be provided. The Federal Circuit has cautioned that an Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

No such showing has been made in the present Office Action. It is submitted that the reason why no such showing was made is because the prior art of record individually or combined, fail to teach, suggest, or otherwise provide the motivation needed to make such a modification. "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness." Ex Parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985). In addition, Applicants respectfully request the Examiner produce a reference supporting the Official Notice as well as particular motivation for modifying the same.

The applicant should be presented with the explicit basis on which the Examiner regards

the matter as subject to official notice sufficient to allow the applicant a proper opportunity to challenge that assertion. However, in the present rejection, the Office Action has merely indicated that it is obvious to modify an unknown device. Applicant is therefore not adequately provided any way to refute the same. There is no way to know if a wireless mouse would be modified as proffered without knowing the underlying support. In addition, as noted above, the wireless pointer of Paull et al. is fundamentally different from wireless mice, as the wireless pointer therein must interactively work with receiver 105. Therefore, without underlying support for the primary reference, i.e., the yet unknown wireless mouse, there is no way to know if such a device would be modifiable as proffered or if such a modification would even be obvious.

In addition, as noted above, the purported motivation for modifying the unknown wireless mouse is not supported by Paull et al., and would therefore appear to be unsupported in the record.

"Rejection of patent application for obviousness under 35 U.S.C. §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record." In re Lee 61 USPQ2d 1430 (CA FC 2002)(vacating a decision by The Board of Patent Appeals and Interferences ("Board") of the USPTO, which upheld an examiner's rejection where the motivation for a specific combination was not supported by the record; the vacated holding of Board was based on the premise that "[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.")

The outstanding rejection similarly sets forth motivation which is unsupported by the record, and thus would appear to be based solely the Examiner's interpretation of what one of ordinary skill in the art would have known. Such an unsupported motivation is thus improper.

Independent claim 1 has also been amended to particularly reference "a receiver comprising a connector detachably electrically connected to and powered by a computer via cable and an AC terminal detachably electrically connected to and powered by an AC adapter, wherein the receiver charges the rechargeable secondary battery cell of the wireless mouse by either one of the connector and the AC terminal."

Paull et al. fails to disclose this claimed AC terminal or the connector detachably

electrically connected to the wireless device or the connector being connected to the mouse. Conversely, Paull et al. merely appears to disclose that the receiver obtains power from the computer. Paull et al. does not disclose an additional AC connector or connecting the connector attached to the computer to the wireless device. In Paull et al. the wireless device is only connected to the receiver, not the computer.

Similarly, independent claim 9 sets forth a wireless mouse connected to a computer by a cable. The Office Action has failed to address at least this feature. In addition, dependent claim 10 further sets forth features of the computer providing direct charging power for the wireless mouse, which is not disclosed in Paull et al.

Further, independent claim 11 particularly indicates the receiver includes two power sources, one from the computer and one separate from the computer. Paull et al. fails to disclose this feature.

In addition, the Office Action would only appear to have detailed in the rejection independent claim 1, without discussing the particulars recited in the dependent claims. For example, without limiting the differentiating remarks thereto, dependent claims 4-5 set forth the selectivity of outputting differing signals based upon the type of USB connector and claim 7 details the use of a solar battery cell, at least neither of which is detailed in the Office Action nor disclosed in Paull et al. In addition, new independent claim 13 also particularly sets forth a solar cell collecting light emitted from the light emitting element to charge the battery of the wireless mouse.

Regarding the USB connectors, of claims 3-5, the Office Action has indicated that such connectors are well known in the art. But similar to above has failed to provide motivation support for the same and its applicability to the proffered combination. Applicants respectfully request a reference be produced supporting this conclusion. In addition, particular rationale addressing the obviousness of each recited claim features, which has not be set forth in the rejection, is required.

Further regarding the rejection of claims 7 and 8, which recite at least the use of a solar cells, the Office Action merely indicates that such features would merely be design choice.

However, to set forth a prima facie obviousness case, evidenced motivation must be provided indicating why one skilled in the art would be motivated, lead, or suggested to modify an existing reference in view of another reference. It is improper to base a rejection on the claimed feature being merely a design choice. See *In re Garrett*, 1986 Pat. App. LEXIS 8 (Bd.

Pat. App. 1986), where the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences ("Board") specifically stated: "the examiner has not presented any line of reasoning as to why the artisan would have been motivated to so modify the...structure, and we know of none. The examiner's assertion...that the proposed modification would have been "an obvious matter of engineering design choice well within the level of skill of one of ordinary skill in the art" is a conclusion, rather than a reason." Similar discussions can be seen in *In re Chu*, 36 USPQ2d 1089 (Fed. Cir. 1985).

Therefore, for at least the above, it is respectfully submitted that a prima facie obviousness rejection of the pending claims has not been set forth. Withdrawal of the pending rejections is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: 

Stephen T. Boughner
Registration No. 45,317

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501